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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/779,925	02/17/2004	Aaron Sauve	308353.01	8991
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			EXAMINER BAYERL, RAYMOND J	
			ART UNIT 2173	PAPER NUMBER

DATE MAILED: 11/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/779,925

Applicant(s)

SAUVE ET AL.

Examiner

Raymond J. Bayerl

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 January 2005, 17 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 - 2, 5 - 15, 18 - 22, 26 - 32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 - 2, 5 - 15, 18 - 22, 26 - 32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 17 Feb 2004.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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1. The disclosure is objected to because of the following:

At paragraph [0054], it appears that reference numeral **526** was intended where "426" is given, in the discussion of fig 5.

At paragraph [0070], "prompt 807" should correctly mention **805**, in discussing fig

8A.

Appropriate correction is required.

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 27 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

At lines 5 – 6, claim 27 recites "the further objects" without clear antecedent basis—it is only non-parent claim 26 that introduces "further objects", and not parent claim 21.

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 21 – 22, 26 – 30 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Applicant presents claims directed to a "computer-readable medium", but without the contemplated "medium" being necessarily restricted to a tangible fixing of the "computer-executable instructions". At paragraph [0092], applicant specifies that

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"computer readable media may comprise 'computer storage media' and 'communications media.'", and at paragraph [0094], "'Communication media'" may hold the "computer readable instructions" in "a modulated data signal, such as a carrier wave".

Thus it is, that applicant seeks a claim that can simply be a "signal" or a "carrier wave", and these do not possess sufficient structure as to represent a practical application of the technological features of the "instructions" that would qualify as a "process, machine, manufacture, or composition of matter". Both a "signal" and a "wave" represent ephemeral and transitory phenomena, and under current PTO policy, these do not contain such physical structure as needed, for 35 USC 101.

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

7. Claims 1 – 2, 5 – 10, 21 – 22, 26 – 31 rejected under 35 U.S.C. 102(a) as being anticipated by Pennell et al. ("Pennell", US #2003/0098883 A1).

As per independent claim 1's "displaying an advisory that an action for an object associated with a webpage is blocked", Pennell blocks windows categorized as bad windows, while allowing windows categorized as good windows to be displayed (Abstract). As is particularly seen in Pennell's fig 8, a blinking tray icon such as icon 801 of FIG. 8 may be displayed to alert the user that bad windows have been blocked (paragraph [0081]). The blocking of bad windows in Pennell is accompanied by the

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retention of such information as the number of windows that have been blocked and the domains where windows have been blocked (paragraph [0075]). This is achieved in the environment of web browser 302, which informs listener 306 of browser event notifications of where the new window is navigating to (paragraph [0042]). The icon 801 in Pennell therefore advises the user that, in the course of web browser navigation, “an action for an object associated with a webpage is blocked”, when such an “object” qualifies as a “bad window” (see also paragraph [0043]).

As per claim 1’s “displaying a description of the object”, please note further in Pennell’s paragraph [0081] that Clicking on icon 801 may the bring up a dialog box (not shown) listing all the bad windows that have been blocked; clicking on a listed blocked window would then allow that window to be displayed. The listing of bad windows provides the claimed “description of the object”, and the dialog box is “an interactive prompt corresponding to the object”. The “advisory” in the form of Pennell’s icon 801, on the other hand, is “a modeless prompt”, since it appears simply from the encountering and blocking of bad windows in the Pennell web browser session.

When Pennell will allow that window to be displayed, “the interactive prompt” (the dialog box) “enables user interaction to unblock the action” (claims 2, 22), and present the “object” whose “action” had been “blocked”.

As per claim 6’s “description” that appears “in accordance with descriptions of further blocked objects”, so as to allow such “objects to be acted upon”, Pennell identically provides a listing of plural bad windows, these being the ones encountered

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and “blocked” during the user session. A similar line of reasoning applies to claims 26, 27, 31, 32.

The “description of the object” in a Pennell listing “is presented in response to a user action”, as in claim 7, this being done by clicking on icon 801, as in claim 8’s “clicking as a pointer hovers over a portion of the advisory” (see also claim 28).

The alternative listing “wherein the object associated with the webpage” “includes **any one of...**” in claims 9, 18, 29 is met by the inevitable obtaining in Pennell of some form of “downloadable code”. Because bad windows in Pennell are related to additional network resources by the nature of their being used in advertising (Pennell, paragraph [0006]), the “object” in such a case “is a link to an object on a remote server”, as in a separate website “file” that will use “video”, “audio” or “text” (claims 10, 19, 30).

Independent claim 5 presents a recitation that is broader than claim 1’s, in that no “interactive prompt” or “modeless prompt” is called for, but also that the “description of the object” that appears with the “advisory that an action for an object associated with a webpage is blocked” is “displayed in connection with a sequential listing of blocked objects”. However, the “advisory” reads upon Pennell’s icon 801 and the “description” upon the listing of bad windows, and such a listing has plural “sequential items”, as in the above discussion regarding claim 6.

Independent claim 21 merely has the “advisory” and “description” regarding the “blocked” “object associated with a webpage”, which also appears in the icon 801/listing arrangement of Pennell.

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

10. Claims 11 – 15, 18 – 20, 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pennell in view of "Google Toolbar Options Help" ("Google"; http://toolbar.google.com/popup_help, 4 December 2003).

Independent claim 11 is similar to claim 21, noted above as being anticipated by the icon 801/listing features of Pennell, but further recites the use of "a text field to display an advisory that an action for an object associated with a webpage has been suppressed". The best that is seen in Pennell's fig 8 is a blinking tray icon that has the letter B, which is not reasonably interpreted as being "a text field".

However, Google's Pop-up Blocker, as appears in the Google exemplary illustration of a Google Toolbar, has a "text field" legend to the effect that 3 blocked new

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windows have been prevented from automatically opening when you visit a website.

This pop-up blocker button, an “advisory” that responds to a click, also acts as does Pennell, to provide additional access regarding “an object” that has been “suppressed”; specifically, to permit entry of a site to your whitelist.

It would therefore have been obvious to a person having ordinary skill in the art to modify an “advisory”/“description” presentation for a “suppressed” “object”, as in Pennell, with a “text field” within the “advisory”, as seen in Google, so that the Pennell user has better appreciation of the “object”-suppression that occurs, when it has blocked bad windows. Motivation appears at least in Pennell, where the magnitude of difficulty as seen in Google’s indication, for example, of 3 blocked, will assist the user in investigating and possibly remedying the problem of unwanted “objects” attempting to activate.

Within the Google screen, the Toolbar “displaces the webpage” (claim 12), in its introduction into the browser frame. By allowing the user to click on the pop-up blocker button, Google further provides “a modal prompt to enable user interaction with the text field” (claim 13), and in the case of Pennell, this can “activate the action”. The Pennell listing takes the form of a “modal prompt” to “activate” that is selected “as a cursor points to a portion of the text field” in Google (claim 14). The listing of bad windows Pennell reads upon claim 15’s “cascading listing of objects associated with the web page having corresponding actions suppressed”. The “text field” “advisory”, as initially appearing spontaneously in Google in response to suppression, “is a modeless prompt” (claim 20).

11. Applicant's arguments filed 17 June 2005 have been fully considered but they are not persuasive.

In the preliminary remarks in the Petition To Make Special under MPEP 708.02 (VIII), applicant argues at page 12 that "The Google toolbar screen-shot shows a UI that does provide a warning that objects, or 'popups,' have been blocked, as shown by the description '2 blocked.'", but that "the toolbar does not display a description of the blocked objects". However, the highly-relevant reference Pennell, which was not listed in applicant's Petition, shows that a "description" may be accessed by clicking on icon 801, as discussed above. This forms an obvious combination under 35 USC 103 with Google for the reasons stated above, and thus, the claims are not "patentably distinguishable" over the prior art now made of record, as in applicant's request for a "Notice of Allowability" at page 13 of the Petition.

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The reference McKinlay et al. (US #2004/0083474 A1) is in the listing provided in the Petition, and it is listed on the attached form PTO-892 where it had not previously been indicated on a form PTO-1449.

The other US Patent documents made of record generally relate to the handling of objects that accompany downloaded webpages.


13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raymond J. Bayerl whose telephone number is (571)

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272-4045. The examiner can normally be reached on M - Th from 9:00 AM to 4:00 PM ET.

14. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Cabeca, can be reached on (571) 272-4048. All patent application related correspondence transmitted by FAX **must be directed** to the central FAX number (571) 273-8300.

15. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-2100.



RAYMOND J. BAYERL
PRIMARY EXAMINER
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8 November 2005